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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,415	08/03/2001	Hirotaka Inagaki	401181	7811
23548	7590	05/13/2005	EXAMINER	
LEYDIG VOIT & MAYER, LTD 700 THIRTEENTH ST. NW SUITE 300 WASHINGTON, DC 20005-3960			COBURN, CORBETT B	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/830,415	INAGAKI ET AL.
Examiner	Art Unit	
Corbett B. Coburn	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 January 2005.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1,2,7-9,11-19,22-25,27-33 and 35-43 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1,2,7-9,11-19,22-25,27-33 and 35-43 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 06 January 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/28/05

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ .

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 5-9, 11, 18-20 & 23-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugawa (JP 09-056896) in view of Fraley (US Patent Number 4,712,799).

Claims 1, 11, 31: Ugawa teaches a pachinko game machine (Fig 1) with means (2) for displaying a special symbol indicating a shift to a special game state if a varying display (33a-c) stops at a specific arrangement and for displaying a game-related production display (Fig 40). There is a start win sensor (13) for detecting a game ball entering a start win hole and outputting a detection signal to the means for controlling a display. The detection signal triggers display of a production -- i.e., the reels spin when the ball goes in the hole. There is a means (61) for determining results of stopping of the varying display and controlling the means for displaying according to the results. The means for determining controls the means for displaying to produce a production display of a scenario of a game-related production display from beginning to end of the scenario (Figs 41-43) during a period from a start to an end of the varying display, wherein said game-related production display includes a design of at least two different characters (Fig 38 shows two characters) and a word (or attachment) design (Fig 36) shown simultaneously with the stopping of the varying display that indicates at least one of a special game state probability and probability of a reach, the reach indicating a shift to the special game

state if the varying display stops an additional special symbol at a specific stop arrangement. Ugawa fails to teach word or attachment designs for each of the two different characters and the combination of word designs including exchange of words between two different characters. This is, however, purely a matter of aesthetics. Ugawa teaches displaying a picture that performs the claimed function. The content of the picture is an aesthetic design choice. It is well known to make an aesthetic design choice of the pictures on gaming displays to illustrate a chosen game theme. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided word (attachment) designs for each of the two different characters including a conversation between the two characters as a aesthetic design choice to illustrate a theme chosen by the game designer.

Ugawa does not specifically teach a lookup table and the process of looking designs up in such a table using the random number generated as part of playing the game. Ugawa does teach displaying the same figure on the screen each time a particular random number occurs (i.e., each time a particular game situation occurs). It is notoriously well known to use look-up tables in read only memory to store game images in gaming machines and to use the random number generator to pick the image displayed – this is how video gaming machines work. This is probably how Ugawa works, but Ugawa is silent on this point; possibly because the feature is so well known. Fraley does explicitly disclose this feature. (Fig 8) Video gaming devices are more flexible than mechanical devices because they can display a greater range of images. It would have been obvious to one of ordinary skill in the art at the time of the invention to have

modified Ugawa in view of Fraley to use look-up tables in read only memory to store game images in gaming machines and to use the random number generator to pick the image displayed in order to make use of the flexibility offered by video displays.

Computer programs are obviously embodied in a game machine-readable medium – the program described in Ugawa could not work unless the machine could read it.

Claims 2, 27: The end of the scenario indicates whether to shift to the special game state. (Abstract)

Claim 5: The means for determining changes the production display to show an evolution of the scenario when a state of the game becomes the reach. (Fig 42 B)

Claim 6: Figs 36A shows the evolution of the scenario is indicated by changes in a background of the production display. The spinning reels form a changing background.

Claims 7, 28: Fig 38 shows that the progress of the scenario shown with the production display changes with the two different characters. In certain circumstances, one character leaves and another appears.

Claim 8: The production display indicates moving on to the special game state with the two different characters. (Fig 38)

Claims 9, 30: Fig 1 clearly shows that the means for displaying includes a display zone for the production display larger than a display zone for the varying display of the special symbol. The reels take up the lower third of the display. The upper two-thirds of the display is reserved for the production display.

Claims 18, 24: Ugawa teaches a production pattern determination table. (Figs 5, 6, 10, 17) The particular arrangement of the table used is a matter of design choice, wherein no

stated problem is solved, or unexpected result obtained, by using the specific arrangement of the table claimed versus the arrangement of the table taught by the prior art.

Claims 19, 25: Ugawa teaches two characters who appear to be of opposite sexes. (Fig 37)

Claims 20, 26: As a computer, Ugawa obviously has a memory for storing a production pattern determination table (Figs 5, 6, 10, 17) including production patterns for the game-related production display, and a random number generator for generating a random number for production pattern determination, wherein the random number is used to determine a production pattern to be displayed.

Claims 23 & 32: Claims 23 & 32 are a rehash of claims 1 and 11 respectively (which see) with the addition of a “true intention design”. Ugawa fails to teach “true intention designs”. As described in Applicants specification, these “true intention designs” are merely additional indicators on the basic character symbols. In effect, the basic character symbol with the word character symbol, and the “true intention symbol” combine to form one symbol. The appearance of that symbol is an aesthetic design choice.

Claim 29: Ugawa teaches a production display that uses symbols to indicate moving on to the special game state. The appearance of the symbols is a matter of aesthetic design choice.

3. Claims 12-15, 17, 21, 22 & 33-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ugawa in view of Fuchs (US Patent Number 5,630,753) and Fraley.

Claims 12, 17, 33, 39, 43: Ugawa teaches the invention substantially as claimed. Ugawa teaches a game machine with means (2) for displaying game-related designs including a

special symbol (k) indicating a shift to a special game state if a varying display stops at a specific arrangement. There is a production design indicating a probability of shifting to the special game state (Fig 3). There is a means (50A) for controlling a display on the means for displaying. Ugawa does not explicitly teach that the means for controlling controls the means for displaying to produce a suggestion display of a relationship between the production design and the probability of shifting to the special game state -- i.e., a help-table explaining odds of winning. Yet it is well known that for full enjoyment of the game, it is necessary for the player to have extensive knowledge of the predictive characteristics of the predictive display mode. Fuchs teaches displaying such a table (7). The suggestion display is produced when the game is not being played or when the game is being played and the varying display of the special symbol is not shown on the means for displaying, and the suggestion display implicitly notifies a player of the game of the relationship -- the help table appears on the screen even when the reels are not spinning. This provides the player with information needed to understand the game, thus making it more enjoyable for the player to play. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ugawa to include a suggestion display as suggested by Fuchs in order to provide the player with information needed to understand the game, thus making it more enjoyable for the player to play.

Ugawa fails to teach that the production design includes at least two different characters and the combination of word designs including exchange of words between two different characters. This is, however, purely a matter of aesthetics. Ugawa teaches displaying a picture that performs the claimed function (indicating a special game state

probability and probability of a reach). The content of the picture is an aesthetic design choice. It is well known to make an aesthetic design choice of the pictures on gaming displays to illustrate a chosen game theme. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a production design with at least two different characters including a conversation between the two characters as a aesthetic design choice to illustrate a theme chosen by the game designer.

Ugawa does not specifically teach a lookup table and the process of looking designs up in such a table using the random number generated as part of playing the game. Ugawa does teach displaying the same figure on the screen each time a particular random number occurs (i.e., each time a particular game situation occurs). It is notoriously well known to use look-up tables in read only memory to store game images in gaming machines and to use the random number generator to pick the image displayed – this is how video gaming machines work. This is probably how Ugawa works, but Ugawa is silent on this point; possibly because the feature is so well known. Fraley does explicitly disclose this feature. (Fig 8) Video gaming devices are more flexible than mechanical devices because they can display a greater range of images. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Ugawa in view of Fraley to use look-up tables in read only memory to store game images in gaming machines and to use the random number generator to pick the image displayed in order to make use of the flexibility offered by video displays.

Computer programs are obviously embodied in a game machine-readable medium – the program described in Ugawa could not work unless the machine could read it.

Claims 13, 36: Fuchs teaches showing which combination of symbols (corresponding to the production design) has a high probability of winning (i.e., shifting to a special game state). Clearly to be of any use whatsoever in teaching the player to interpret the meaning of the production design, the suggestion display must indicate which production designs indicate a high probability of shifting to the special game state.

Claims 14, 37: Fuchs teaches the suggestion display shows a design related to the production design – both the production design (the cards (3)) and the suggestion display (7) depict cards with diamonds. Clearly to be of any use whatsoever in teaching the player to interpret the meaning of the production design, the suggestion display must show a design identical to the production design or related to the production design.

Claims 15, 38: Ugawa teaches animated images. The movement of the images indicates different things. In order to effectively teach the meaning of the production designs, it would be necessary to show the player what these production designs do. This means that it would be necessary to show the animation. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used animated images in the suggestion display in order to teach the player the meaning of the production designs.

Claims 21, 34: Ugawa teaches a production design that includes a design of at least two different characters (Fig 37 shows two characters) and a word (or attachment) design (Fig 40) shown simultaneously with the stopping of the varying display that indicates at least one of a special game state probability and probability of a reach, the reach indicating a shift to the special game state if the varying display stops an additional special symbol at a specific stop arrangement. Ugawa fails to teach word or attachment designs for each of

the two different characters. Having word (attachment) designs to explain the two different characters would provide information to the player to make the meaning of the characters clear. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided word (attachment) designs for each of the two different characters in order to provide information to the player to make the meaning of the characters clear.

Claims 22, 35: Ugawa teaches the invention substantially as claimed. Ugawa fails to teach “true intention designs”. As described in Applicants specification, these “true intention designs” are merely additional indicators on the basic character symbols. In effect, the basic character symbol with the word character symbol, and the “true intention symbol” combine to form one symbol. The appearance of that symbol is an aesthetic design choice.

Claims 40-42: As pointed out above, the appearance of the image displayed on the gaming machine is a matter of aesthetic design choice to illustrate a particular game theme.

Response to Arguments

4. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.
5. Applicant argues that “aesthetic design choice” is not a basis for a *prima facie* case of obviousness. Examiner disagrees. The only difference between Applicant's invention and Ugawa is that Applicant displays a different set of pictures than Ugawa. The pictures have the exact same function in both cases – to notify the player of different game conditions. It is the

function of the pictures that may be protected by a patent – not the pictures themselves. If a separate patent could be issued for each minor aesthetic change in graphics displayed on a screen, then no patent would provide any protection of intellectual property.

6. Let us look at it from another point of view. Suppose Applicant were granted a patent on this invention and Ugawa then applied for a patent using his disclosure. Ugawa says, “My pictures are different from Applicant’s.” Would Applicant agree that Ugawa has a patentable invention? Of course not. Applicant would rightly say that the function of the pictures is what is patentable – not the aesthetic design of the pictures themselves. Yet Applicant wishes to argue that Ugawa should not be afforded the same protection that Applicant would expect if granted a patent.

7. Clearly, since there are an infinite number of aesthetic design variations that could be contemplated for a system such as Applicant’s, to base patentability on differences in the aesthetics of the pictures would deprive a patent of any meaning. Thus “aesthetic design choice” may form the basis of a *prima facie* case of obviousness.

Conclusion

8. This is an RCE of applicant's earlier Application No. 09/830,415. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Corbett B. Coburn whose telephone number is (571) 272-4447. The examiner can normally be reached on 8-5:30, Monday-Friday, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jessica Harrison can be reached on (571) 272-4449. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



cbc



JESSICA HARRISON
PRIMARY EXAMINER